

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES C. NEGUS, ROBERT I. RUDKO,
STEPHEN J. LINHARES and STEPHEN M. PEREZ

Appeal No. 95-4462
Application 08/190,950¹

HEARD: APRIL 8, 1998

Before McCANDLISH, *Senior Administrative Patent Judge*, STAAB
and McQUADE, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-11, all the claims pending in the application.

¹ Application for patent filed February 3, 1994.

Appellants' invention pertains to a handpiece for use with a medical laser system. A basic understanding of the invention can be derived from a reading of exemplary claim 1, the sole independent claim on appeal, which reads as follows:²

1. A handpiece for a medical laser system comprising:
a barrel having a passage for transmitting a laser beam; and
a contacting wall attached to one end of said barrel, said wall including: an aperture in communication with said passage in the barrel, a solid face extending radially outward from said aperture to the periphery of said contacting wall, and a knurled surface on said face for preventing movement of said contacting wall with respect to the heart wall^[3] during surgery;

wherein said aperture has a diameter which is substantially similar to the diameter of said passage; and

² Subsequent to a new ground of rejection in the examiner's answer, claim 1 was amended by an "amendment" found within the body of the reply brief (Paper No. 11). We point out, however, that the practice of using the reply brief in lieu of a separate paper to amend claims is improper and inappropriate. See the last paragraph of MPEP 1208 and the penultimate sentence of 37 CFR § 1.193(b). Since the reply brief includes on page 1 the handwritten note "Please Enter," and since the examiner has responded in the supplemental examiner's answer (Paper No. 12) in a manner which indicates that the "amendment" included in the reply brief has been accepted, we will assume that the version of claim 1 found on pages 1 and 2 of the reply brief constitutes a correct copy of appealed claim 1.

³ The term "the heart wall" lacks antecedent basis.

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wherein said periphery of said contacting wall has a diameter which is at least twice the diameter of said aperture in order to provide greater surface area over which to disperse the pressure imposed by said handpiece on the heart wall and to facilitate perpendicular alignment of the handpiece with respect to the heart wall.

The references of record relied upon by the examiner in support of the rejections are:⁴

Pollock 1915	1,135,465	Apr. 13,
Sharon et al. (Sharon) 1975	3,865,113	Feb. 11,
Vassiliadis et al. (Vassiliadis) 1990	4,940,411	Jul. 10,

Claims 1-5 and 8-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sharon in view of Pollock. Claims 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sharon in view of Pollock and further in view of Vassiliadis.⁵

⁴ The examiner inadvertently failed to include the Vassiliadis reference in the list of references relied upon on page 3 of the answer.

⁵ These are new rejections made for the first time in the examiner's answer. In each instance, the examiner no longer includes the McFee reference (incorrectly denominated "Fee" in the final rejection) in support of the rejection. Since the rejections in the final rejection relying in part on McFee have not been restated in the examiner's answer, we presume

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The rejections are explained in the examiner's answer (Paper No. 10) and the supplemental examiner's answer (Paper No. 12).

The opposing viewpoints of appellants are set forth in the brief (Paper No. 9) and the reply brief (Paper No. 11).

OPINION

We have encountered substantial difficulty in understanding precisely what is meant by certain claim language in the appealed claims. Our difficulty centers on the recitation added to claim 1 subsequent to the final rejection that the diameter of the aperture "is substantially similar to" the diameter of the passage in the barrel.

When words of degree such as "substantially similar" are used in a claim, our reviewing court has directed us to look to appellants' specification to determine if it contains "some standard for measuring that degree," that is, whether one of ordinary skill in the art would understand the scope or metes and bounds of the claimed subject matter when read in light of the specification. *See Seattle Box Co. v. Industrial Crating*

that they have been withdrawn. *See Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957).

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& Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

In the present case, the question raised by appellants' claim language is how far the diameter of the aperture may depart from the diameter of the passage in the barrel and yet be considered "substantially similar to" the barrel passage diameter. In looking to appellants' specification for the necessary guidance, we find nothing therein that would reasonably apprise one of ordinary skill in the art as to the threshold between those aperture diameters that are "similar to" a given passage diameter and those that are not, much less those aperture diameters that are "substantially similar to" a given passage diameter and those that are not. In fact, appellants' specification gives no hint whatsoever as to the degree to which the diameter of the aperture may depart from the diameter of the passage and yet be considered "substantially similar" thereto.

Absent the necessary guidelines for making such a determination, there is no way for us to determine the scope of the claimed subject matter with a reasonable degree of precision for evaluating the possibility of infringement and

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dominance. See *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

While we might speculate as to what is meant by that claim language, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art as we are obligated to do. Rejections under 35 U.S.C. § 103 should not be based upon "considerable speculation as to meaning of the terms employed and assumptions as to the scope of such claims." *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Accordingly, we are constrained to reverse the examiner's rejections of the appealed claims as being unpatentable over the prior art. We hasten to add that this is a procedural reversal rather than one based upon the merits of the rejections. We take no position as to the pertinence of the prior art as applied by the examiner in his rejections.

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Pursuant to our authority under 37 CFR 1.196(b), we make the following new rejections.

Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph. For the reasons discussed above, the appealed claims fail to particularly point out and distinctly claim the subject matter which appellants regard as the invention for the reasons discussed above. Specifically, we are unable to determine with any reasonable degree of precision the metes and bounds of the terminology "said aperture has a diameter which is substantially similar to the diameter of said passage" appearing in claim 1.

Claims 1-11 are also rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification that fails to provide descriptive support for the invention as now claimed. Our difficulty with the claim language with respect to the description requirement found in the first paragraph of § 112 is based on the recitation added to claim 1 subsequent to the final rejection that the periphery of the contacting wall has a diameter which is "at least twice" the diameter of the aperture in the contacting wall.

As stated in *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ

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1089, 1096 (Fed. Cir. 1983) (citations omitted):

[t]he test for determining compliance with the written description requirement [found in the first paragraph of 35 U.S.C. § 112] is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. The content of the drawings may also be considered in determining compliance with the written description requirement.

The requirement that the diameter of the periphery of the contacting wall is "at least twice" the diameter of the aperture in the wall encompasses a range of ratios which includes the ratio 2 as a lower limit, and which has no upper limit. There is no support in the original disclosure for the diameter of the periphery of the contacting wall 32 being *twice* the diameter of the aperture 26, as now covered by claim 1. Likewise, there is no support in the original disclosure for the diameter of the periphery of the contacting wall 26 being *any* diameter greater than twice the diameter of the aperture 26, as also now covered

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by claim 1. Accordingly, appellants' specification does not provide descriptive support for the claim limitation in question.

With respect to our new rejections, we have considered the remarks found in appellants' communication submitted April 17, 1998 (Paper No. 18), but do not find them to be persuasive that the specification provides adequate support for the claim language in question.

Summary

The standing rejections of the appealed claim under 35 U.S.C. § 103 are reversed on procedural grounds. We take no position as to the pertinence of the prior art as applied by the examiner in his rejections.

Pursuant to our authority under 37 CFR § 1.196(b), new rejections of the appealed claims under 35 U.S.C. § 112, first and second paragraphs, have been made.

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

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37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED, 37 CFR § 1.196(b)

HARRISON E. McCANDLISH)
Senior Administrative Patent Judge)
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LAWRENCE J. STAAB
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

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